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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,723	01/22/2001	Jeffrey B. Hoke	3912E (DIV)	2047

7590

03/16/2006

Chief Patent Counsel
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EXAMINER

JASTRZAB, KRISANNE MARIE

ART UNIT

PAPER NUMBER

1744

DATE MAILED: 03/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,723

Applicant(s)

HOKE ET AL.

Examiner

Krisanne Jastrzab

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 49-52 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Fromson et al., U.S. patent No. 5,711,071. See column 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beitz et al., EP 634205A (abs).

Beitz et al., teach incorporating an ozone decomposing catalyst onto the equipment in air conditioning and ventilating equipment. It is active at normal ambient temperatures to decompose ozone in an air stream. Beitz et al., do not specifically recite that the catalyst is incorporated onto an outdoor component of the air conditioning or ventilation system, however, they clearly specify that it is functional at ambient or normal atmospheric temperatures, and it is commonly recognized that our atmosphere contains a measurable degree of ozone. As such, it would have been obvious to one of ordinary skill in the art to include the catalyst of Beitz et al., on an outdoor component of an air conditioning or ventilating system, such as a condenser, because it would effectively combat the influx of ozone into an air conditioned residence.

Double Patenting

Claims 49-52 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 22-25 of U.S. Patent No. 5,620,672. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are of the same inventive concept with '672 reciting a specific ozone treating catalyst for the apparatus claimed in the instant claims, the ozone decomposing capability of the recited catalyst being well recognized in the art and therefor obvious in it's application. '672 further claims application of the catalyst to components such a fan blades, which are well recognized as part of an outdoor component of an air handling system.

Terminal Disclaimer

The terminal disclaimer filed on 1/4/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. patent No. 5,620,672 has been reviewed and is NOT accepted.

The person who signed the terminal disclaimer has failed to state his/her capacity to sign for the corporation or other business entity or organization, and he/she has not been established as being authorized to act on behalf of the assignee.

Response to Arguments

Applicant's arguments filed 1/4/2006 have been fully considered but they are not persuasive.

Applicant argues that the rejection as stated above in view of Beitz, acts on an airstream drawn into or out of a building, not the atmosphere as claimed, however, the Examiner would disagree and point out that rejection as applied above would clearly treat atmospheric air and would further note that the environment within a building is not excluded from the atmosphere.

Applicant further argues that the treated air is returned to the atmosphere by the claimed invention, however, the Examiner would point out that the claimed invention is directed to an apparatus with no requirement that the air be returned to the atmosphere and the rejection in view of Beitz, as set forth, meets the structural limitations of the claims.

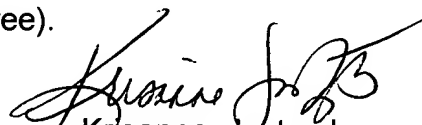
Applicant finally argues that one of ordinary skill in the art would not be motivated to place the catalyst of Beitz on an outdoor component of the air conditioning system because the conditions that the catalyst would be exposed to would be different than those of the indoor components, however, the Examiner would maintain that moving the catalyst would in no way destroy the reference, has proper motivation based on the well recognized presence of ozone in the outdoor atmosphere, and based on the teaching that it would be effective under ambient or atmospheric conditions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisanne Jastrzab whose telephone number is 571-272-1279. The examiner can normally be reached on Mon.-Wed. 6:30am-4:00pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on 571-272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Krisanne Jastrzab
Primary Examiner
Art Unit 1744

March 14, 2006